

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Art Unit 3622

Davis et al

Confirmation No. 4530

Application No.: 09/697,009

Filed: October 25, 2000

**VIA ELECTRONIC FILING**

For: DIGITALLY MARKED OBJECTS AND  
PROMOTIONAL METHODS

Examiner: J. Janvier

Date: July 17, 2006

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**REPLY BRIEF**

Sir:

This Reply Brief is in responsive to the Examiner's Answer mailed May 24, 2006. We respectfully refer the Board to our Appeal Brief, which fully addresses the final rejection of the claims. This Reply Brief provides a few observations regarding the Examiner's Answer.

We respectfully renew our request that the final rejection of the pending claims be reversed.

Please charge any fees required for this brief to our deposit account 50-1071.

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**GROUNDS OF REJECTION**

Claims 2 and 5-7 stand rejected under § 103 over Lemon (taken in context with asserted “Official Notice”).

(The Examiner’s Answer removes the previous § 102 rejection over Lemon. Please see the Examiner’s Answer, page 9, paragraph 10.)

**REPLY****1. The Official Notice Confuses the Record**

Since 2003 Appellants have asked the Examiner to substantiate asserted Official Notice so that the rejections could be fully addressed, and properly considered by the Board.<sup>1</sup> But despite repeated requests, the Examiner did not do so.

Official Notice is again advanced in the Examiner’s Answer. And this time it even further confuses the record.

The Examiner’s Answer twice suggests that:

*[A] watermark is a mark, which is difficult to reproduce and it is laid over some other existing information for the purpose of identification and authenticity of the underlying information (e.g., visible watermark on US currency).<sup>2</sup>*

And then in summarizing this Official Notice the Examiner’s Answer suggests:

*[T]he ‘Official Notice’ recites that digital watermark is placed on US currency such as a dollar bill, which is well known and capable of instant and unquestionable demonstration. Here, the dollar bill is evidence or the proof to support the ‘Official Notice’.<sup>3</sup>*

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<sup>1</sup> Please see our July 28, 2003, Amendment, pages 2-3; December 19, 2003, Response After Final, page 1; and March 31, 2005, Amendment After Final., lines 11-12.

<sup>2</sup> Please see the Examiner’s Answer on page 8, lines 2-4 and page 12, last two lines – page 13, line 1. (underlining added).

<sup>3</sup> See the Examiner’s Answer, page 15, lines 12-14. (underlining added).

The summary of the Official Notice uses the term "digital watermark" (page 15) while the actual discussion of the Official Notice uses the term "visible watermark" (pages 8 and 12-13).

We *think* that the Examiner's Answer intended to use the term "visible watermark" in the summary (page 15) based on the earlier sections (pages 8 and 12-13).

But this is a problem with the asserted Official Notice -- we are forced to guess at the intended evidence sought to be noticed. In contrast, if the Examiner would simply substantiate the record the rejection could be fully addressed and properly considered by the Board.

And since we are forced to guess, we guess that the term "visible watermark" is intended in the summary (page 15) because the Examiner's Answer suggests that such a watermark would be capable of instant and unquestionable demonstration and based on the earlier discussion regarding currency (pages 8 and 12-13). For example, currency could be held up to the light to visually inspect the presence or absence of a visible watermark.

But why cite to a visible watermark since there is no discussion of how a visible watermark could be presented to a reader device to decode information there from (*cf.* claim 5) or presented to different reader devices to trigger first and second different responses (*cf.* claim 2)? For example, there is no evidence in the Official Notice that information can be decoded from a visible watermark. So the use of a visible watermark is not even helpful to reject the claims and the Official Notice regarding such only serves to further confuse the record.

The asserted Official Notice confuses the record, hinders Appellants' ability to address the rejection and makes difficult a proper appellate review.

Thus, we again traverse the Official Notice and ask that the final rejection be reversed.

## 2. **The Conclusions drawn from Appellants' Admissions are Unfounded**

The Examiner's Answer makes some bold – but unsubstantiated – assertions based on Appellants' admission in the specification. For example, on page 13, the Examiner's Answer notes:

*Furthermore, contrary to the Appellant's contention, watermarking a coffee cup or a coffee cup jacket, a book cover, a driver's license, a dollar bill, etc., (or placing the watermark on a coffee cup or jacket for a coffee cup, a book cover, a driver's license, a dollar bill . . .) is a matter of choice or desires, design specification or a matter of convenience, which does not directly affect or impact the functionality or the utility of the system and in the end produces the same result. Technically speaking, the watermark can be placed on any article of commerce or product (including a credit card) without affecting the functionality of the system, which is operable to produce a first response at a first location and a second and different response at a second location.<sup>4</sup>*

The Examiner's Answer calls the above disclosure "Official Notice"<sup>5</sup>.

But this Official Notice doesn't attempt to explain how or why functionality or utility of a system is not directly affected, or how this Official Notice teaches first and second different responses, or how watermarking a driver's license and dollar bill is merely a matter of convenience, or even why such statements are capable of instant and unquestionable demonstration.

These are not the type of statements that are of instant and unquestionable demonstration.

And this is all in contrast to Appellants' actual statement on page 1, lines 29-31 of the specification: "*A great variety of particular watermarking techniques are known to artisans in the field. One particular technique is shown in application 09/503,881, filed February 14, 2000.*"<sup>6</sup>

This specification statement is not a license to make unsupported allegations and call them "Official Notice".

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<sup>4</sup> Please see the Examiner's Answer, page 13, lines 6-14 (underlining removed and emphasis added).

<sup>5</sup> Please see the Examiner's Answer, page 13, lines 15-16.

<sup>6</sup> The Examiner's Answer cites the subject specification at page 15, lines 15-16.

Indeed, such Official Notice stretches Appellants' statement beyond reason.

The Office has fallen short of establishing *prima facie* obviousness; we respectfully submit that the rejections should be reversed.

### **CONCLUSION**

None of the rejections meets the Office's burdens. Accordingly, the Board is respectfully requested to reverse the pending final rejections.

Date: July 17, 2006

Respectfully submitted,

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